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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,366	02/27/2002	Tsung-Hsiung Wang	WANG3118/EM	5874

23364 7590 06/12/2003

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EXAMINER

PADGETT, MARIANNE L

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 06/12/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/083,366

Applicant(s)

Wang et al

Examiner

M.L. Palyett

Group Art Unit

1762

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-10 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-10 are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-2, drawn to a method of coating using microwave plasma pretreatment of the substrate with following conductive polymer coating, classified in Class 427, subclass 535.

II. Claims 3-4, drawn to product claims directed to an unknown material, plasma treated to unstated effect, classified in Class 428, subclass 411.1.

III. Claims 5-10, drawn to product claims ambiguously directed to possibly a coated substrate or the composition of the coating on the substrate, classified in Class 428 or 252, subclass 500, or 500, respectively.

2. It is noted that with respect to the dependent claims of 3-10, especially 5 and 6, that the statutory class of these claims is somewhat ambiguous or obscured by the non-standard claim language, hence applicants might wish to consider amendment or rewriting of the claims when making their election. Further proofreading and correction of the claims might also be considered, for example not all limitations are positively stated; claims 1 & 8, both consists of two sentences, not one as is required; and at the end of claim 6 units of i with an accent and m (î m) are very unfamiliar to the Examiner. If applicant did not actually intend the dependent claims 3-10 or some portion

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thereof to actually be the product claims, appropriate amendment of those claims to clarify the statutory class, so that their limitations further limit the process limitations of the method claims, would obviate the restriction requirement for those claims so amended.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Groups II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the various product claims require either materials or parameters not required by the process claims, hence may be made by different processes than required for the method claims. Furthermore, it is noted that the various dependent product claims are said to be dependent only on a portion of claim 1, hence as such do not formally require the process of forming those products to include the other portions of claim 1.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group II or III is not required for Group I, restriction for examination purposes as indicated is proper.

5. A telephone call was made to Eugene Mar on 6/3/03 to request an oral election to the above restriction requirement, but did not result in an election being made. Mr. Mar was not available, however the Examiner was told that another attorney in the firm would return her call but no return call was ever received as of June 12, 2003. Thus, this requirement is being mailed.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of

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inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication should be directed to M. L. Padgett from Monday through Friday from about 8 A.M. to 4:30 P.M. at telephone number (703) 308-2336 and FAX #703 872-9310 (official), 872-9311 (official after final) and 305-6078 (unofficial).

MLPadgett:cdc 6/9/03

June 12, 2003

A handwritten signature in cursive script, appearing to read "Marianne Padgett".

**MARIANNE PADGETT
PRIMARY EXAMINER**